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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,732	09/26/2001	Fu-Pao Tsao	LP/V-31596A	9316
7590	05/24/2004		EXAMINER	
Thomas Hoxie Novartis Corporation Patent and Trademark Dept. 564 Morris Avenue Summit, NJ 07901-1027			PAK, JOHN D	
			ART UNIT	PAPER NUMBER
			1616	
			DATE MAILED: 05/24/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/963,732	TSAO, FU-PAO
Examiner	Art Unit	
JOHN D PAK	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 March 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-16 is/are rejected.
 7) Claim(s) 2 and 12 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

Claims 1-16 are pending in this application.

Claims 1-16 will continue to be examined to the extent that they read on the elected subject matter of record, sodium perborate + diethylene triamine penta(methylenephosphonic acid), hereinafter referred to as "DTPMP."

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al. (US 5,725,887) for the reasons of record.

Applicant's claim amendments and remarks relative hereto have been given due consideration, but they were deemed unpersuasive. The independent claims have been amended so that the solution pH is greater than 8.0. Applicant argues that Martin et al. do not disclose pH greater than 8.0. However, a close review of Martin et al. shows their pH to be between "about 5.5 and **about 8**" (emphasis added). See column 7, lines 16-17. The Examiner interprets "about 8" to be clearly inclusive of at least 8.01 or 8.1.¹ For the term "about" to have any meaning at all, it must encompass a value

¹ Apparently, applicant intends "greater than 8.0" to be broad enough to still include pH 8.0. See dependent claims 2 and 12. Examiner's claim interpretation is further supported by applicant's own claims.

outside of 8.0. A value outside of 8.0 satisfies the amendatory feature, "pH greater than 8.0." Since a pH value that is outside of 8.0 such as pH 8.01 or 8.1 meets applicant's amendatory claim language, the disclosure by Martin et al. still anticipates the presently amended claims.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Appleby et al. (US 5,827,808).

Appleby et al. explicitly discloses a dishwashing solution that contains sodium perborate + DTPMP². See formulations A, B, C, D, E and F on column 20. The formulations "have an unduly high pH, in preference having a pH measured as a 1% solution in distilled water of from 8.0 to 12.0, more preferably from 9.0 to 11.8, most preferably from 9.5 to 11.5" (column 18, lines 57-62). In the exemplified formulations A to F, supra, the 1% pH is 10.7 (see column 20, lines 28-29).

The claims are thereby anticipated. The following additional discussion is provided to further explain the basis for the anticipation of some of the dependent claim features.

Hydrogen peroxide from 2-100 ppm: The actual use-concentration of Appleby's formulation is in the range of 0.05-2% by weight (column 3, lines 30-35). Therefore, the pH measurement at the 1 wt% concentration is an accurate measurement of the actual

² Appleby et al. refer to DTPMP as "DETPMP." These are alternative names for the same compound.

use-composition that is also disclosed. In Appleby's formulations A to F, the 1 wt% diluted formulations would contain 0.012 wt% PB1, which is anhydrous sodium perborate monohydrate, which provides about 0.004 wt% hydrogen peroxide. This is equivalent to 40 ppm hydrogen peroxide.

pH between 8.0 and 9.5: The most preferred pH range of the aforementioned 1 wt% dilution is from 9.5 to 11.5 (column 18, lines 60-61). Therefore, at a minimum, pH 9.5 is explicitly disclosed.

As discussed above, all of the claimed features are explicitly disclosed by Appleby et al. The claims are anticipated.

Claims 2 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The independent claims have been amended to require the pH to be "greater than 8.0." Dependent claims 2 and 12 still read on "pH of between 8.0 and 9.5." If applicant intends 8.0 to be still within "greater than 8.0," the Examiner suggests amending the independent claims to read "greater than about 8.0."

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**, effective February 3, 2004. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Thurman Page, can be reached on (571)272-0602, effective February 3, 2004.

The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.



JOHN PAK
PRIMARY EXAMINER
GROUP 1000